

REMARKS

In the Office Action, the Examiner rejected claims 1-31. By the present Response, Applicants amend claims 3, 5, 7, 8, 12, 14, 18, and 19 to further clarify the claimed subject matter. Upon entry of the amendments, claims 1-31 will remain pending in the present patent application. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of all pending claims.

Objection to the Drawings

In the Office Action, the Examiner objected to the drawings, stating that the drawings must show every feature of the invention specified in the claims. More particularly, the Examiner stated: “the ‘a hard drive securing mechanism’ claimed in claim 1, and ‘a securing lever mechanism operable to secure a plurality of hard drives to the hard drive carrier’ in claim 14 must be shown or the feature(s) canceled from the claim(s).” Office Action mailed October 20, 2004, page 2. However, the Examiner’s objection is untenable because embodiments of these claimed features are clearly illustrated in the present drawings.

For example, an embodiment of a “hard driving securing mechanism” (e.g., 40) is clearly illustrated in many of the figures, including FIG. 2. *See also, e.g.*, FIGS. 4-6. Further, an embodiment of a “securing lever mechanism operable to secure a plurality of hard drives to the hard drive carrier” (e.g., 60) is also clearly illustrated in several of the figures, including FIG. 2. *See also, e.g.*, FIGS. 4-9. It is also clear from the figures that securing lever 60 is operable to secure a plurality of hard drives (e.g., 66 and 108) to the hard drive carrier. Because all of the supposedly missing elements are clearly illustrated in the present figures, Applicants respectfully request withdrawal of the Examiner’s objection to the drawings. Applicants stress that the foregoing features are merely embodiments of the features recited in the claims.

Objection to the Specification

In the Office Action, the Examiner objected to the specification as failing to provide proper antecedent basis for the claimed subject matter. Specifically, the Examiner suggests that a “hard drive securing mechanism,” as recited in claim 1, is not discussed in the specification. However, this objection is also untenable. The specification describes an embodiment of such a mechanism (e.g., 40) throughout the specification. *See, e.g.*, Application, page 11, lines 6-22; *see also, e.g., id.* at page 15, line 15 – page 18, line 15. Because the specification provides abundant antecedent basis for the claimed subject matter, Applicants respectfully request withdrawal of the Examiner’s objection to the specification. Again, Applicants stress that the foregoing features are merely embodiments of the features recited in the claims.

Claim Objections

In the Office Action, the Examiner objected to claims 3, 5, 7, 8, 12, 14 and 18 for various informalities. Although Applicants do not necessarily agree with the Examiner’s objections, Applicants amended the claims as set forth above. In view of these amendments, Applicants believe the Examiner’s objections are moot. Accordingly, Applicants respectfully request withdrawal of the Examiner’s objections to the claims.

Claim Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1-9, 11-19, 22-25, and 28-31 under U.S.C. § 102(b) as anticipated by Cooke et al. (U.S. Patent No. 5,112,119). Applicants respectfully traverse this rejection.

Legal Precedent

Anticipation under Section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under Section 102, every element of the claimed invention must be identically shown in a single reference. *In re*

Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under Section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “*in as complete detail as contained in the . . . claim*” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Omitted Features of Independent Claim 1

The Cooke et al. reference fails to disclose each element of independent claim 1. For instance, independent claim 1 recites, among other things, “a hard drive securing mechanism . . . operable to secure a plurality of hard drives to the chassis *with a rotatable lever*” (emphasis added). As discussed below, the Cooke et al. reference fails to disclose such an element. Consequently, the Cooke et al. reference cannot anticipate independent claim 1.

The Cooke et al. reference is directed to an apparatus for housing devices, such as disk drives, within a computer. *See* col. 1, lines 7-10. To this end, the Cooke et al. reference teaches an apparatus having an enclosure or case 15 and a disk drive support structure 20. *See* col. 3, lines 18-20; FIG. 1A. Further, the cited reference teaches a drive retainer 420 having retainer contact tabs 535 that act as respective stops at one end of the support structure 20 to prevent movement of drives in a single direction. *See* col. 14, lines 6-12; *see also* FIGS. 19A and 19B. In other words, the drive retainer 420 simply blocks removal of a disk drive already installed in the structure 20, rather than providing any leverage over the course of attaching the drive retainer 420 to the structure 20. *See id.*

In rejecting independent claim 1, the Examiner asserted that drive retainer 420 reads on the “rotatable lever” recited in the instant claim. *See* Office Action mailed October 20, 2004, page 4. However, this assertion is a mischaracterization of both the Cooke et al. reference and the ordinary meaning of the term “lever” as understood by one of ordinary skill in the art. Applicants respectfully note that one skilled in the art would appreciate that a lever is a mechanical object that is used to transmit force to a second object upon rotation about a pivot or fulcrum. However, as noted above, the drive retainer 420 merely retains disk drives within the structure 20. It does not transmit *any* force to a second object.

In operation, the drive retainer 420 functions much like a lid to a cardboard box: closing the lid may prevent an object from exiting the box, but merely constraining movement of the object does not make the lid a “lever.” Similarly, while the drive retainer 420 may rotate into position and block the disk drives from exiting the structure 20, it does not transmit any force through the rotation. As indicated by the terminology employed by Cooke et al. and shown in the figures of the cited reference, the drive retainer 420 merely retains the disk drives within structure 420, thereby constraining the movement of the disk drives. As such, the drive retainer 420 cannot rationally be equated with a “rotatable lever” as recited in independent claim 1. Further, because the Cooke et al. reference fails to teach or suggest a “rotatable lever,” the cited reference necessarily fails to disclose “a hard drive securing mechanism . . . operable to secure a plurality of hard drives to the chassis *with a rotatable lever*” (emphasis added). Thus, Applicants believe independent claim 1, as well as its dependent claims, is patentable over the Cooke et al. reference.

Omitted Features of Independent Claim 14

Similarly, the Cooke et al. reference fails to disclose every recitation of independent claim 14. For example, independent claim 14 recites, in part, “a *securing lever mechanism* operable to secure the plurality of hard drives to the hard drive carrier”

(emphasis added). However, as discussed above with respect to independent claim 1, the Cooke et al. reference fails to disclose any element that can be reasonably compared to a securing lever. As a result, the Cooke et al. reference fails to disclose every element of, and cannot anticipate, independent claim 14. Accordingly, Applicants believe independent claim 14, as well as its dependent claims, is patentable over the Cooke et al. reference.

Omitted Features of Independent Claim 22

Further, the Cooke et al. reference also fails to teach or suggest each element of independent claim 22. By way of example, independent claim 22 recites “disposing a first hard drive between a first restraint and *a securing lever*” (emphasis added). Further, claim 22 also recites “*rotating the securing lever* to ... secure the first hard drive” (emphasis added). However, as discussed above in reference to claim 1, the Cooke et al. reference fails to disclose any such lever. Thus, the Cooke et al. reference fails to anticipate independent claim 22. Applicants, therefore, believe independent claim 22, as well as its dependent claims, is patentable over the Cooke et al. reference.

Omitted Features of Independent Claim 28

Additionally, the Cooke et al. reference fails to disclose every limitation of independent claim 28. For instance, independent claim 28 recites, among other things, “a plurality of guides, each guide being configured to receive a protruding member when *the securing lever* is in a first position” (emphasis added). However, as discussed above, the Cooke et al. reference does not disclose a securing lever, and therefore cannot disclose the recited plurality of guides. Because the Cooke et al. reference fails to disclose each element of the instant claim, the cited reference cannot anticipate independent claim 28. Consequently, Applicants believe independent claim 28, as well as its dependent claims, is patentable over the Cooke et al. reference.

For these reasons, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 102 and allow claims 1-9, 11-19, 22-25, and 28-31.

Claim Rejections under 35 U.S.C. § 103(a)

The Examiner rejected claims 10, 20-21, and 26 under 35 U.S.C. § 103(a) as obvious over Cooke et al. in view of Kikinis (U.S. Patent No. 5,539,616) and claim 27 under 35 U.S.C. § 103(a) as obvious over Cooke et al. in view of Bologna et al. (U.S. Patent No. 6,442,021). Applicants respectfully traverse these rejections.

Request Removal of Commonly Assigned Reference under 103(c)/102(e)

First, Applicants respectfully submit that the Bologna et al. reference does not qualify as prior art against the above-referenced application under 35 U.S.C. § 103(a). In accordance with 35 U.S.C. § 103(c) and Pub.L. 106-113, § 4807, enacted November 29, 1999, subject matter which qualifies as prior art only under subsection (e) of 35 U.S.C. § 102, shall not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. At the time the present invention was made, the invention disclosed by this application and the invention disclosed in the Bologna et al. reference were both owned by Compaq Computer Corporation. Further, it is clear that the Bologna et al. reference only qualifies as prior art under 35 U.S.C. § 102(e). Thus, in accordance with 35 U.S.C. § 103(c) and M.P.E.P. § 706.02(l)(3), it is clear that the Bologna et al. reference does not qualify as prior art that may be used in a rejection under 35 U.S.C. § 103(a).

Without the Bologna et al. reference, the Examiner's rejection of claim 27 under 35 U.S.C. § 103(a) is moot. Further, it is clear that none of the art of record and available as prior art discloses or suggests all of the elements recited in the present claims. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejections and allowance of claim 27. However, if the Examiner chooses to provide a new ground of

rejection, Applicants request that the Examiner provide a sufficient rationale for the rejection, using available prior art, in a future non-final Office Action, in accordance with M.P.E.P. § 706.07(a).

Omitted Features of Dependent Claims 10, 20-21, and 26

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985).

With respect to the rejection of claims 10, 20-21, and 26, as discussed above, the Cooke et al. reference fails to disclose every element of independent claims 1, 14, and 22, from which claims 10, 20-21, and 26 respectively depend. Further, the Kikinis reference fails to obviate the deficiencies of the Cooke et al. reference. As a result, claims 10, 20-21, and 26 are allowable on the basis of their dependency from an allowable independent claim, as well as by virtue of the subject matter separately recited in each dependent claim. Accordingly, Applicants respectfully request withdrawal of the Examiner's rejection and allowance of claims 10, 20-21, and 26.

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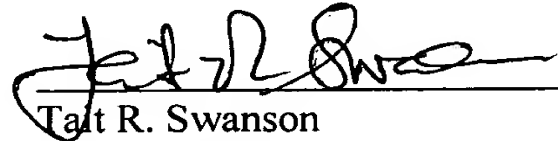
For these reasons, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 103 and allowance of claims 10, 20-21, and 26-27.

Conclusion

Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

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